

**Appln No. 10/799,143**  
**Amdt date April 20, 2007**  
**Reply to Office action of October 20, 2006**

### **REMARKS/ARGUMENTS**

This amendment is submitted in response to the Office action mailed October 20, 2006. Claims 1, 2, 5, 6, 21, 22, 25 and 26 have been amended. Claims 3, 4, 23 and 24 have been cancelled without prejudice. Claims 9-15 have been withdrawn pursuant to a restriction requirement. In addition, previously presented claim 28 has been withdrawn in accordance with the restriction requirement. Claims 29 and 30 have been added to more completely cover certain aspects of the invention. Accordingly, claims 1-2, 5-8, 21-22, 25-27 and 29-30 are presently in the application for examination.

On page 2 of the Office action, it is noted that Applicant has not filed a certified copy of the German application. Applicant submits a certified priority document herewith.

On pages 2-5 of the Office action, claims 1-5, 7-8, 21-25 and 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webb in view of Jackson, and claims 6 and 26 are rejected under 35 U.S.C. 103(a) for being unpatentable over Webb in view of Jackson and further in view of Hall. Applicant respectfully traverses the rejections.

Claims 1 and 21 recite that the legs of the receiving member comprise "a first internal thread" and that the securing member comprises "a screw member having a first external thread that engages and cooperates with the first internal thread." Further, the receiving part comprises "an internal undercut" and the first internal thread extends "to the undercut." Neither Webb nor Jackson teach or suggest an internal thread on the legs of the receiving member that extends to an internal undercut. Accordingly, Applicant respectfully submits that claims 1 and 21 are patentable over the cited art.

Claims 2, 5-8, 22 and 25-27 depend from one of claims 1 and 21. Since these claims depend from one of claims 1 and 21 and because they contain additional limitations further distinguishing these claims from the cited art when considered as a whole, these claims are also believed to be patentable.

New independent claims 29 and 30 have been amended to more completely cover certain aspects of the invention. In particular, claims 29 and 30 recite that "the first thread comprises fewer than four full turns." Support for this recitation is found in FIGs. 1-3, which each show

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that the internal thread of the legs of the receiving part has fewer than four thread turns. An advantage of this feature is that "the overall height of the receiving part is reduced as compared to the conventional anchoring elements." See the Substitute Specification at paragraph 21. Applicant respectfully submits that claims 29 and 30 are patentable.

In view of the above, Applicant respectfully requests reconsideration of the application and the allowance of claims 1, 2, 5-8, 21, 22, 25-27 and 29-30.

Accompanying this amendment is an Information Disclosure Statement, which contains references mailed to the Office in two separate submissions by a third party on November 15, 2004.

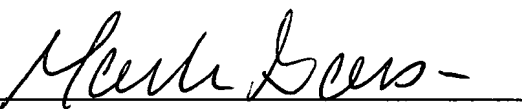
One of the references submitted to the Office relates to the present application, namely U.S. Patent No. 5,474,555 to Puno, and assigned to Cross Medical Products (the Cross patent). The owner of the present application, Biedermann Motech GmbH, is familiar with the Cross patent because it was asserted against its exclusive licensee in a confidential arbitration proceeding, which is now concluded. The Cross patent was also asserted in litigation against Medtronic Sofamor Danek, Inc. In the Medtronic litigation, Cross asserted that a Medtronic screw infringed claim 5 of the Cross patent.

In a recent U.S. Court of Appeals for the Federal Circuit decision, *Cross Medical Products, Inc. v. Medtronic Sofamor Danek, Inc.* (05-1415, March 20, 2007), the Court found that a Medtronic screw that "replaced the threading that extends below the diameter of a rod in its original screws with an undercut that does not engage any surface of the corresponding set screw" does not infringe claim 5 of the Cross patent under the doctrine of equivalents because "the use of an undercut or recess, the alleged equivalent here, is an old and well known fundamental of basic machining that was entirely foreseeable at the time of the amendment to one of ordinary skill in the art. See, e.g., John R. Walker, *Machining Fundamentals, Fundamentals Basic to Industry*, at 185-86 (1981); U.S. Patent No. 5,129,900; U.S. Patent No. 5,190,543". See pages 8 and 12-13 of the Federal Circuit decision attached to the accompanying Information and Disclosure Statement.

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For purposes of examining this application only, Applicant admits that a design change to the Cross patent calling for the threads to end at a depth above the diameter of the rod with an undercut extending below the diameter of the rod was foreseeable to a person of skill in the art at the time of the invention described in the present application and that it was known, at the time of the invention described in the present application, to provide systems in which threads terminated above the rod and set screws that extended below the threads were used to apply compressive forces to a rod.

Respectfully submitted,  
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